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Joseph G. Radzik

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TYCO INTERNATIONAL
9 ROSZEL ROAD
PRINCETON, NJ 08540

EXAMINER

WRIGHT, GIOVANNA COLLINS

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH G. RADZIK

Appeal 2008-0535
Application 09/965,983
Technology Center 3600

Decided: June 13, 2008

Before MURRIEL E. CRAWFORD, DAVID B. WALKER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a pipe coupling gasket comprising a one-piece elastomeric member with axial open ends, a circumferential wall, and a pair of circumferential flanges. The circumferential walls extend radially inwardly at the open ends to form a channel. A coating of dry powder lubricant is placed on the inner circumferential side of the gasket. (Specification, [0003]). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A lubricated ferrous pipe coupling gasket comprising:

a generally tubular, one-piece, elastomeric member with first and second axial open ends, the member being formed by a circumferential wall and at least a pair of circumferential flanges, each flange extending at least generally radially inwardly at a separate one of the first and second axial open ends of the member, the circumferential wall and the pair of circumferential flanges forming at least one circumferential channel on an inner circumferential side of the member; and

a powder coating that provides a dry lubricant on at least the inner circumferential side of the pair flanges of the member.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Larsen	US 4,230,157	Oct. 28, 1980
Holt	US 5,070,597	Dec. 10, 1991
Sisk	US 5,540,465	Jul. 30, 1996
Dole '907	US 5,642,907	Jul. 1, 1997
Dole '450	US 6,302,450	Oct. 16, 2001

The following rejections are before us for review:

1. Claims 1, 5-6, 10, 16, 20-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dole '450, Larsen, and the Appellants Prior Art Disclosure.
2. Claims 2-4, 7-9, and 17-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dole '450, Larsen, the Appellants Prior Art Disclosure, and Holt.
3. Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Dole '450, Larsen, the Appellants Prior Art Disclosure, and Sisk.
4. Claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Dole '450, Larsen, the Appellants Prior Art Disclosure, Sisk, and Dole '907.
5. Claims 13-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dole '450, Larsen, the Appellants Prior Art Disclosure, Sisk, and Holt.

FINDINGS OF FACT

We find the following enumerated findings of fact to be supported by at least a preponderance of the evidence¹:

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

1. Dole '450 discloses a iron pipe coupling 10 with two split coupling segments 12, 14 and a fastener 22, 24 (Col. 4:41-Col. 5:7). Figure 5 discloses that a gasket 32 with an interior channel is used in the coupling. The coupling gasket 32 is lubricated (Col. 5:16-21).
2. Larsen discloses a pipe seal with a lubricant placed at locations 9 and 9'. The lubricant is described as being selected from different types including talcum powder, graphite, wax, grease, and oil. (Col. 6:7-21).
3. Holt discloses a tubular article that has friction reducing material between its walls (Abstract). Holt discloses that corn starch may be used as a friction reducing material (Col. 13:3-15).
4. Sisk discloses a pipe valve or tee coupler (Abstract).
5. Dole '907 discloses an end fitting for a sprinkler system (Abstract).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these

questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

ANALYSIS

The Appellant argues that the rejection of claim 1 under Dole, Larson, and the Appellant’s Disclosure is improper. The Appellant argues that Larsen fails to teach that that a dry powder lubricant is suitable to be used in place of a grease lubricant on a gasket (Br. 15). The Appellant further argues that Larsen specifically discloses the lubricant to be placed in only two locations. The Appellant argues that because the specificity of the two disclosed locations, Larsen therefore fails to provide any suggestion to combine the features of Larsen with Dole. The Examiner in contrast argues

that the combination is properly made because Larsen discloses that talcum powder is an art recognized equivalent for grease lubricants (Ans. 4). The Examiner also argues that the Appellant's Specification discloses that it is well known to lubricate the inner surface of a gasket to prevent damage during installation (Ans. 5).

We disagree with the Appellant. Dole '450 has disclosed the claimed pipe coupling structure which includes a gasket 32 having an inner channel (FF 1). Dole '450 also discloses that the gasket 32 is lubricated (FF 1). Larsen discloses a pipe seal which may use talcum powder as a lubricant as well as other lubricants such as grease, graphite, and oil (FF 2). The Appellants Specification acknowledges that gaskets are typically coated with oily liquid or grease to more easily slip over piping components (Spec. 6:18-20). One of ordinary skill in the art would readily recognize from the disclosure of Larsen that talcum powder could be used interchangeably as a lubricant in other pipe seals. One of ordinary skill in the art would not consider the locations for applying the talcum powder in pipe seals to be limited to only those two specific sealing surfaces disclosed by Larsen. We hold the modification of Dole '450 to include the use of talcum powder for lubrication as disclosed by Larsen to be an obvious predictable use of prior art elements for their known functions.

For the above reasons, the rejection of claim 1 under Dole '450, Larsen, and the Appellants Prior Art Disclosure is sustained. The Appellants argument for the patentability of claims 5-6, and 10, are the same as those drawn to claim 1. Claims 5-6 and 10 therefore fall with claim 1, as the arguments presented for those claims were not for separate reasons. See 37

C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

With regard to claims 16 and 20-23 the Appellant argues that “Dole fails to show or describe a ferrous pipe as claimed” (Reply Br. 24). This argument appears not to have been presented before in the Appeal Brief. Dole ‘450 has disclosed that the pipe coupling is made from iron (ferrous material) (FF 1). We find that one of ordinary skill in the art would obviously see the rationale to use the ferrous pipe coupling of Dole ‘450 with a ferrous pipe to have materials which bonded and adhered well with each other mechanically to form a tight seal. For the reasons above, we sustain the rejection of claim 16, and 20-23 under Dole ‘450, Larsen, and the Appellants Prior Art Disclosure.

The Appellants argument for the patentability of claims 2-4, 7-9, and 17-19 under Dole ‘450, Larsen, the Appellants Prior Art Disclosure, and Holt are the same as those drawn to claim 1. Accordingly for the reasons above, the rejection of claims 2-4, 7-9, and 17-19 is sustained.

The Appellants argument for the patentability of claim 11 under Dole ‘450, Larsen, the Appellants Prior Art Disclosure, and Sisk are the same as those drawn to claim 1. Accordingly for the reasons above, the rejection of claim 11 is sustained.

The Appellants argument for the patentability of claim 12 under Dole ‘450, Larsen, the Appellants Prior Art Disclosure, Sisk, and Dole ‘907 are the same as those drawn to claim 1. Accordingly for the reasons above, the rejection of claim 12 is sustained.

The Appellants argument for the patentability of claim 13-15 under Dole '450, Larsen, the Appellants Prior Art Disclosure, Sisk, and Holt are the same as those drawn to claim 1. Accordingly for the reasons above, the rejections of claims 13-15 is sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting under 35 U.S.C. § 103(a): A) Claims 1, 5-6, 10, 16, 20-23 under Dole '450 Larsen, and the Appellants Prior Art Disclosure; B) Claims 2-4, 7-9, and 17-19 under Dole '450, Larsen, the Appellants Prior Art Disclosure, and Holt; C) Claim 11 under Dole '450, Larsen, the Appellants Prior Art Disclosure, and Sisk; D) Claim 12 under Dole '450, Larsen, the Appellants Prior Art Disclosure, Sisk, and Dole '907; and E) Claims 13-15 under Dole '450, Larsen, the Appellants Prior Art Disclosure, Sisk, and Holt.

DECISION

The Examiner's rejection of claims 1-23 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

vsh

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TYCO INTERNATIONAL
9 ROSZEL ROAD
PRINCETON NJ 08540